

REMARKS

Reconsideration and allowance of the present application are respectfully requested. Independent claims 40 and 41, along with dependent claims 63-78, remain pending in the application, although the Examiner has improperly withdrawn claims 64-70 and 72-78 from consideration. Claims 63 and 71 have been amended, and support appears, for example, at specification page 6, second paragraph and page 20, last paragraph. Claims 1-39 and 42-62 had been previously canceled.

In numbered paragraphs 2-3 of the Office Action, the Examiner has asserted that claims 64-70 and 72-78 have been withdrawn from consideration as having been "constructively" non-elected. While Applicant agrees that each of these claims is directed to features which, on their own, are separately patentable, these are dependent claims which, at best, constitute species of the generic claims. The Examiner has failed to set forth the various species to which the claims are directed, and afforded Applicant an opportunity to elect one of those species. Thus, the restriction is respectfully traversed, and if it is to be maintained, the species must be enumerated so that Applicant can elect a species and identify those claims which read on the elected species.

On pages 4-5 of the Office Action, the Examiner sets forth a "Response to Arguments". The Examiner asserts that:

It would have been obvious for a person of ordinary skill in the art at the time of applicant's invention to modify Farrell and Bober by punching/cutting the sheets sheet by sheet, as disclosed by Albright, for the purpose of punching/cutting sheets without interrupting their rapid sequential sheet printing and output, yet allowing improved, more positive, sheet control at a lower punching/cutting force as compared to compiling and hole punching/cutting through an entire set of sheets at once.

These comments of the Examiner, and the maintaining of the rejections of Applicant's independent claims 40-41, along with dependent claims 63 and 71, are respectfully traversed. In numbered paragraph 5 on page 3 of the Office Action, claims 40-41, 63 and 71 are rejected, as being unpatentable over U.S. Patent No. 4,595,187 (Bober) in view of U.S. Patent No. 6,120,015 (Albright et al). In numbered paragraph 4 on page 3 of the Office Action, claims 40-41 are rejected as being unpatentable over U.S. Patent No. 5,461,469 (Farrell et al) in view of the Albright patent.

These rejections are respectfully traversed, as the patents relied upon by the Examiner, considered individually in the various combinations suggested by the Examiner, fail to teach or suggest Applicant's invention as set forth in independent claims 40 and 41. For example, none of the patents relied upon by the Examiner, teach or suggest registering hole punched sheets. That is, these documents when considered individually or in the combinations relied upon by the Examiner, fail to teach or suggest punching a hole, or cutting out a notch, in a sheet on a sheet-by-sheet basis, and collecting and registering the sheets, each of which has a fold, on a sheet-by-sheet basis. In addition, there would have been no motivation or suggestion to have combined the patents relied upon in the Office Action in the manner suggested by the Examiner. However, even if these documents could have somehow been combined, they would not have resulted in Applicant's presently claimed invention. The Examiner's "Response to Arguments" on pages 4-5 of the Office Action, fails to address the absence of any teaching of features from claims 40 and 41 in the documents relied upon by the Examiner, even when these documents are combined in the manner set forth in the Office Action.

Claim 40 specifically recites punching a hole in the sheets, sheet-by-sheet; collecting the sheets in a stack on the workpiece, sheet-by-sheet, said sheets having a fold therein. Claim 40 also recites registering the sheets on the workpiece, sheet-by-sheet, with the fold in each sheet. Thus, hole punched sheets are registered on the workpiece.

The Bober patent is directed to a saddle stapler accessory. Figure 1 of this patent illustrates a printing machine 10 which includes a saddle stitcher 70. Figure 2 illustrates that the saddle stitcher 70 includes a creasing roll 74. The roll 74 is shown in Figure 5 to include a ridge 71 for placing a crease in a sheet which passes between the rolls 74 and 72. Sheets which pass through the roll 72 and 74 include a weakened area 76 as shown in Figure 6. The weakened area 76 facilitates folding of the sheets onto a roof-shaped compiler tray 79 of Figures 2 and 3. See column 3, lines 55-57. Fold forming baffles 90 and 91 have a surface adjacent the compiler trays 79 so that sheets leaving the creasing rolls are guided into conforming in shape to that of the compiler tray. The sheets are registered on the compiler tray 79 against first registration gates 80 and 81.

The Bober patent does not teach or suggest registering hole punched sheets to one another. As acknowledged by the Examiner, Bober does not even teach or suggest punching a hole in sheets or cutting out a notch in selected sheets on a sheet-by-sheet basis as presently claimed.

The Examiner refers to the Albright patent at column 2, lines 32-48 as disclosing individual hole punching of printed sheets, but this patent does not teach or suggest registering hole punched sheets as presently claimed. Figure 1 of this patent illustrates an exemplary hole punching system 20 which includes separate

sheet paths 23 and 24. A shared, common punch driver system 30 is used in both the paths 23, 24. A transverse sheet punch assembly 31 includes three sheet punches 32a, 32b and 33c on one side for the first sheet path 23, and three other sheet punches 33a, 33b and 33c on the opposite side for the other sheet path 24. After sheets are punched, they are ejected into merging paths to form a common output path 28 of Figure 1, as described in column 8, lines 42-46. The Albright patent does not teach or suggest collecting sheets, sheet-by-sheet, wherein said sheets each have a fold therein, and are registered on a workpiece, sheet-by-sheet, with the fold in each sheet.

The Bober and Albright patents, even if combined in the manner suggested by the Examiner, would not have resulted in registering hole punched sheets as presently claimed. The Bober patent provides no teaching or suggestion of any hole punching or notch cutting capability, and therefore provides no teaching or suggestion as to how such a feature could have been incorporated in the system disclosed. The Albright patent is not directed to registering hole punched/folded sheets on a sheet-by-sheet basis, and there is no teaching or suggestion in the Albright patent as to how such a feature could have been incorporated with the system of Bober.

Applicant's independent claims 40 and 41 are directed to combinations of features which include a hole punching, or notch cutting, capability on a sheet-by-sheet basis, in combination with collecting of the sheets in a stack on a workpiece, sheet-by-sheet, said sheets each having a fold therein, and registering the sheets on the workpiece, sheet-by-sheet, with the fold in each sheet. Such combinations are neither taught nor suggested by these patents. At best, any combination of the

Bober and Albright patents would have resulted in registering folded sheets of Bober on a compiler tray without regard to any hole punching that may or may not have been performed. There is no teaching that registration of any hole punched areas in the plural sheets is of interest in either patent.

Exemplary embodiments of the present invention, as encompassed by independent claims 40 and 41, provide significant advantages. For example, an ability to provide a low-cost, low power method and compact apparatus for manufacturing a booklet, with for example, a desktop laser or ink-jet printer is achieved. Exemplary embodiments provide multiple operations on a sheet-by-sheet basis. Neither of the Bober and Albright patents teach or suggest any desire to register hole punched sheets, nor do they teach or suggest the multiple operations presently claimed as being performed on a sheet-by-sheet basis. As such, claims 40 and 41 are allowable.

Independent claims 40 and 41 are also allowable over the Farrell and Albright patents. The Farrell patent fails to overcome the deficiencies already discussed. For example, this patent is directed to a printing system having a finishing apparatus and does not teach or suggest registering hole punched sheets. The Examiner refers to column 11, line 67 as disclosing a signature booklet maker (SBM) 300 which can be outfitted with a hole punching device. Figure 16 of this patent illustrates a system which includes a saddle stitcher 310, a folder 312 and a trimmer 314. However, the folding is provided after a stitching operation, such that folding is performed on a set of bound sheets as described at column 11, lines 22-26.

As such, this patent teaches away from the presently claimed invention, and it would not have been obvious to have combined the features of the Farrell patent with those of the Albright patent in the manner suggested by the Examiner

Claims 40 and 41 are therefore allowable over the Farrell and Albright patents.

Claims 63 and 71, along with remaining claims that should have been considered by the Examiner, recite additional advantageous features which are neither taught nor suggested by the documents recently relied upon by the Examiner. For example, none of the documents, considered individually or in the combinations relied upon by the Examiner, teach or suggest the features of claims 63 and 71, or the multiple folds, or folding sheets with a fold blade, as recited, for example, in claims 70 and 78.

In light of the foregoing, all of the presently pending claims are allowable.

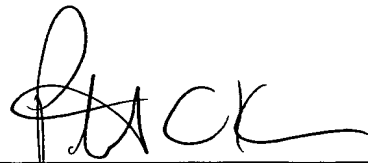
All objections and rejections raised in the Office Action having been addressed, it is respectfully submitted that the application is in condition for allowance and a Notice of Allowance is respectfully solicited.

Respectfully submitted,

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